REMARKS

Applicant hereby traverses the current rejections, and requests reconsideration and withdrawal in light of the remarks contained herein. Claims 21-34 are pending in this application.

Rejection Under 35 U.S.C. § 102

Claims 21-23 and 25-34 are rejected under 35 U.S.C. § 102 as being anticipated by Eichstaedt et al. (US Application 2005/0228703, hereinafter Eichstaedt).

Improper Reference

Applicant notes that Eichstaedt was filed on 30 March 2005, and is a divisional of an application that was filed on 25 April 2001. Both of these dates are after the filing date of the Current Application, namely 6 October 2000. Eichstaedt references four provisional applications, only three of which have dates prior to the filing date of the Current Application. Applicant has reviewed the three provisional applications, namely 60/211285, 60/211254, and 60/228016, and notes that the subject matter relied upon in the Office Action as being cited in Eichstaedt is not disclosed in the provisional applications. For example, the subject matter of paragraphs [0069] and [0104] does not appear to be disclosed in any of the three provisional applications. Thus, Eichstaedt is not a proper reference, and Applicant respectfully requests that the rejection be withdrawn.

Lack of Limitations

It is well settled that to anticipate a claim, the reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim," see M.P.E.P. § 2131, citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim," see M.P.E.P. § 2131, citing Richardson v. Suzuki Motor Co., 9 U.S.P.Q.2d

1913 (Fed. Cir. 1989). Applicant respectfully asserts that the rejection does not satisfy at least one of these requirements.

Claim 21 defines a method for handling an issue related to a design of a product using a computer a system that allows collaboration between a plurality of users. The method includes storing a question related to the issue, storing an answer related to the question, and storing a decision made based on the answer. Eichstaedt does not teach at least these limitations. Claim 21 specifically defines that the method handles an issue related to the design of a product. The section of Eichstaedt relied upon by the Examiner are directed to purchasing goods, not the design of a product, see paragraphs [0069], [0099], and [0101]-[0104]. While portions of Eichstaedt do discuss design, see paragraphs [0015], [0083], [0084], these portions do not disclose the limitations of the method defined by claim 21. Thus, Eichstaedt does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reason claim 21 is patentable over the 35 U.S.C. § 102 rejection of record.

Claims 22-23 and 25-34 depend from base claim 21, and thus inherit all limitations of claim 21. Each of claims 22-23 and 25-34 sets forth features and limitations not recited by Eichstaedt. Thus, the Applicant respectfully asserts that for the above reasons 22-23 and 25-34 are patentable over the 35 U.S.C. § 102 rejection of record.

Furthermore, claim 23 defines that the method of claim 21 further comprises implementing the decision for this issue into the design; and forming the product from the design. Eichstaedt does not teach at least these limitations. The section of Eichstaedt relied upon by the Examiner does not disclose these limitations. Paragraph [0013] is a broad recitation of the purpose of Eichstaedt, and paragraph [0134] discusses inspection and certification. Thus, nothing in Eichstaedt discloses implementing the decision into the design and then forming the product from the design. Consequently, Eichstaedt does not teach all of the claimed limitations. Applicant respectfully asserts that for the above reason claim 23 is patentable over the 35 U.S.C. § 102 rejection of record.

Rejection Under 35 U.S.C. § 103

Claim 24 is rejected under 35 U.S.C. § 103 as being unpatentable over Eichstaedt in view of Thackston (US 6,295,513).

The test for nonobvious subject matter is whether the differences between the subject matter and the prior art are such that the claimed subject matter as a whole would have been obvious to a person having ordinary skill in the art to which the subject matter pertains. The United States Supreme Court in Graham v. John Deere and Co., 383 U.S. 1 (1966) set forth the factual inquiries which must be considered in applying the statutory test: (1) determining of the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3) resolving the level of ordinary skill in the pertinent art, and (4) evaluating evidence of secondary considerations. The current USPTO Guidelines incorporate the mandate of Graham and directs the Examiner to set forth in the Office action the resolution of the factual inquires of Graham and provide a rationale to support the rejection. The rejection must address all of the limitations of the claims.

Lack of Limitations

The Office Action admits that Eichstaedt does not teach having the limitations of claim 24. The Office Action attempts to cure this deficiency by introducing Thackston, which the Office Action alleges to teach having such limitations. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Base claim 21 is defined as described above. Eichstaedt does not disclose these limitations, as discussed above. Thackston is not relied upon in the Office Action as disclosing these limitations. Therefore, the combination of references does not teach all elements of the claimed invention.

Claim 24 depends from base claim 21, and thus inherits all limitations of claim 21. Claim 21 sets forth features and limitations not recited by the combination of Eichstaedt and

Thackston. Thus, the Applicant respectfully asserts that for the above reasons claim 24 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Conclusion

For all the reasons given above, the Applicant submits that the pending claims distinguish over the prior art of record under 35 U.S.C. §§ 102 and 103. Accordingly, the Applicant submits that this application is in full condition for allowance.

Applicant respectfully requests that the Examiner call the below listed attorney if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

In view of the above, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10003655-1 from which the undersigned is authorized to draw.

Dated: July 31, 2008

Respectfully submitted,

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I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).

Dated: July 31, 2008

Signature: _____
Joy H. Perigo